

### REMARKS

Applicants thank the Examiner for the thorough consideration given the present application. Claims 1-18 are currently being prosecuted. The Examiner is respectfully requested to reconsider his rejections in view of the Amendments and Remarks as set forth hereinbelow.

### REASONS FOR ENTRY OF AMENDMENT

It is respectfully submitted that overcoming the Examiner's Rejection based on 35 USC 112 and the cancellation of claim 19 and the addition of the subject matter contained therein into claim 15 automatically places the present application in condition for allowance.

If the Examiner does not agree that the application is in condition for allowance, it is respectfully requested that the present amendment should be entered since the amendment places the application in better form for appeal. The present amendment reduces the issues on appeal by cancelling claim 19 and adding the subject matter to claim 15. The present amendment was not presented at an earlier date in view of the fact that the Applicant did know of the Examiner's new grounds of rejection under 35 USC 112 until they had an opportunity to review the Examiner's last office action. It is requested that the present amendment be entered into the present application.

### RESTRICTION REQUIREMENT

Claims 4-12 stand withdrawn from further consideration. Applicants reserve the right

to file divisional applications directed to the non-elected subject matter. In order to place the present application in condition for allowance, the Examiner is hereby authorized to cancel claims 4-12.

#### REJECTION UNDER 35 USC 112

Claims 1-3 and 13-19 stand rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

At the outset, it is respectfully submitted that features pictorially illustrated in the drawings may be described in the specification without adding any new matter to the application. As set forth in *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ 2d 1111 (Fed. Cir. 1991):

“drawings alone may provide a ‘written description’ of an invention as required by Section 112.”

The Federal Circuit held that because the drawings in a design patent were substantially identical to those in the utility patent, the district court erred in summarily refusing to afford priority to the utility patent. The Federal Circuit remanded the case to the district court to reconsider whether the drawings in the design patent were an appropriate written description of the invention.

In addition, in *In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537 (CCPA 1962) the court held that figure 5 of the application clearly showed that the ring had a mean diameter

corresponding approximately to the mean diameter of an annular chamber. On this basis, the court held that the application satisfied the written description requirement. The Wolfensperger ruling permits the applicants to use the drawings as a basis for subsequent amendments to specification and claims without confronting a new matter rejection.

As set forth in the MPEP Section 608.01(o), the Examiner should scrutinize new claims to ensure that the wording in the claims is set forth in the specification. The first paragraph of this particular section of the MPEP states:

“The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies.”

The last paragraph of this particular section of the MPEP states:

“While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification. Ex parte Kotler, 1901 C.D. 62, 95 O.G. 2684 (Comm’r Pat. 1901).”

It is respectfully submitted that the elements referred to by the Examiner in paragraphs 4a to 4f of his Office Action are illustrated in the drawings. Thus, as discussed with the Examiner during an interview on December 3, 2003, it is permitted to amend the specification to use words to describe the pictorial illustrations in the drawings that support

the wording as presented in Claims 1, 13, 14 and 19. The originally presented disclosure that included the specification, drawings and claims does support the wording as set forth in Claims 1, 13, 14 and 19 in view of the fact that the drawings illustrate the features as set forth in the claims.

More specifically, with respect to the limitation "an entire circumferential edge of said cutout being in contact with said spherical surface" in claims 1 and 19, as was indicated previously in Applicants' Amendment filed on August 7, 2003, page 11, lines 1-9, this limitation is clearly shown in Fig. 4, as well as in the embodiments shown in Fig. 11 and Fig. 12. For example, in the case of Fig. 4, the cutout surfaces (36a, 36b) have a circular edge, which is relatively small in comparison to the greater trunnion surface, so that the entirety of the circular edge is in full contact with the spherical surface (35) of the trunnion. Further, page 13, lines 8-13, of the specification discusses this feature. Namely, because the full edge of the cutoff surface contacts with the spherical surface, which is in surface-to-surface contact with the spherical recess of the annular member when enclosed in the annular member, an oil sump (i.e., lubricating oil retaining space) is created between the cutoff surfaces of the trunnion and the inner spherical recess of the annular member, thereby improving lubrication characteristics, rotary driving force-transmitting ability, and durability.

The feature recited in claim 13, i.e. "a non-circular opening," "a non-spherical interior cutout surface" and "said interior cutout surface being in contact with said spherical recess" are clearly shown in Figs. 5 through 8. Namely, the recess (48) forms a non-circular (i.e.,

elliptical) opening as shown in Fig. 6, and the cutout surface (52) is stated as being elliptical. As shown in Figs. 5, 7 and 8, the surface (52) has a straight interior wall which clearly forms a non-spherical (i.e., an elliptical) surface. Finally, a boundary is formed between the non-spherical surface (52) of the elliptical cutout and the surface of the spherical recess (38); and therefore, the cutout surface (52) is in contact with (i.e., intersects) the surface (38) of the spherical recess. Please also refer to the accompanying descriptions of Figs. 5-8 in the present specification.

With respect to the term "an elliptical opening" and "an elliptical surface" appearing in claim 14, once again, such features are clearly shown and described in connection with Figs. 5 through 8. The opening or cutout (52) is clearly described as being elliptical in the present specification, and hence the recess surface (48) formed by the opening (52) must likewise be elliptical. See also Fig. 10 that clearly illustrates the elliptical opening and the description as set forth on page 12, lines 15-22 of the specification that discusses the inserting the trunnion 28a, 28b, 28c along the substantially elliptic cutout 52 for facilitating the assembly of the trunnion 28a, 28b, 28c relative to the inner roller 40.

As per the discussions with the Examiner, the specification has been amended to include the wording of Claims 1, 13, 14 and 19. Now the illustrations in the drawings, the wording in the specification and the wording in the claims all include the same nomenclature. The Examiner's rejection based on 35 USC 112 has been obviated.

### REJECTION UNDER 35 USC 102

Claims 15, 17 and 18 stand rejected under 35 USC 102 as being anticipated by Turner et al, WO 90/07067. Claims 15, 17 and 18 stand rejected under 35 USC 102 as being anticipated by Matsumoto et al, U.S. 5,256,107. Claims 15, 17 and 18 stand rejected under 35 USC 102 as being anticipated by Mizukoshi, U.S. 5,069,653. These rejections are respectfully traversed.

At the outset, independent claim 15 has been amended to include the subject matter of claim 19. Claim 19 does not stand rejected based on prior art. Thus, overcoming the Examiner's rejection based on 35 USC 112 and amending claim 15 to include the subject matter of claim 19 automatically places claim 15 and the claims that depend therefrom in condition for allowance.

Accordingly, it is respectfully submitted that the combination of elements set forth in amended claim are not anticipated by the prior art relied on by the Examiner. It is respectfully submitted that the prior art cited by the Examiner does not set forth each and every element as defined in the amended claims. Thus, the Examiner's rejection based on 35 USC 102 has been obviated.

### NO PROSECUTION HISTORY ESTOPPEL

Claim 15 has been amended to include the subject matter of claim 19 and to clarify the claim language. No prosecution history estoppel would apply to the interpretation of the

limitations set forth in claims 1-19 in view of the fact that this subject matter has been continuously presented since the original filing date of the present application.

### CONCLUSION

In view of the above remarks, it is believed that the claims clearly distinguish over the patents relied on by the Examiner, either alone or in combination.

Since the remaining patents cited by the Examiner have not been utilized to reject the claims, but to merely show the state of the art, no comment need be made with respect thereto.

In view of the above amendments and remarks, reconsideration of the rejections and allowance of all of the claims are respectfully requested.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

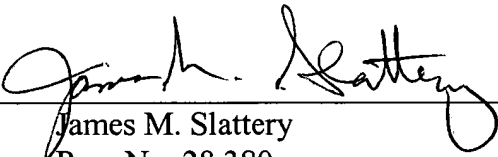
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (703) 205-8000 in the Washington, D.C. area.

A prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
James M. Slattery  
Reg. No. 28,380  
P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

JMS/mmi

0303-0457P